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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,905	12/05/2001	James W. Coiner	47499/VGG/C614	5799
23363	7590	08/10/2004	EXAMINER	
CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			LOCKER, HOWARD J	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015905

Applicant(s)

Coiner

Examiner

H. J. Locker

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on June 01, 2004
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ ~~Claim(s)~~ The claim is ~~is~~ pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ ~~Claim(s)~~ The claim is ~~is~~ rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. The following is a quotation of section (a) of 37 CFR 1.163:

"(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered."

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor in carrying out his invention."

In plant applications filed under 36 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

"No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention."

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

"The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted."

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known varieties and antecedents.

A. At line 28 of page 4, the recitation "Resistance to Disease: Fair" should be deleted, as more detailed/comprehensive (and perhaps conflicting) information is now present later in the specification.

B. Relative to prickles/thorns as recited at page 5 of the specification, the term "usual" should be amended so as to be more descriptive and meaningful.

C. Relative to petal shape, the objectionable language "Longer than wider" still appears in the specification. In addition, the specification now contains no mention of petal shape per se, other than that referenced immediately above, which (to the extent understood) is only comparing length to width and not setting forth a shape per se in meaningful terms.

D. Characteristic petal margin should be set forth in the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible.

E. The recitation "Stigmas: Usual" states nothing in positive or meaningful terms. Correction and/or clarification is necessary.

F. Relative to number of leaflets per compound leaf, the specification should be amended to more accurately and completely account for expression of the plant, particularly as a three leaflet leaf is illustrated in the photographic illustrations originally submitted by applicant.

G. Relative to prickles/thorns as set forth on page 5 of the specification, the recitation "triangle shaped" does not appear to be particularly accurate. Correction and/or clarification is necessary. In this regard, it should be noted that applicant need not refer to the shape of same per se (coloration, relative quantity, and size would be sufficient).

H. Peduncle characteristics should be reviewed for accuracy, as those shown in the photographic illustration filed June 1, 2004 appear to bear numerous small acicular appendages/projections. Coloration should also be reviewed for accuracy and amended so as to account for characteristic anthocyanin coloration, if present.

I. The color designations set forth in the specification relative to petal coloration do not reasonably correspond to the plant as illustrated (either per the photographic illustration originally submitted with this application, or that as submitted on June 1, 2004. Specifically, the petal coloration illustrated is several shades darker and is a much more intense red-orange than the pink coloration represented by the RHS Colour Chart designations set forth in the specification. However, the bud color designations currently set forth in the specification do in fact look to reasonably correspond to the open bloom illustrated. Additionally, applicant has now amended the color designation relative to general tonality from a distance to reasonably correspond to the plant as illustrated, and thus is no longer objectionable.

While such does not appear to be the case from the record at present, should the source of the noted discrepancy be the submitted photographic illustration, it would be necessary for applicant to file a substitute therefor (see 37 CFR 1.165(a) and 1.165(b). Two copies of such would need to be furnished. The plant as described in the specification and the plant as illustrated must reasonably correspond to each other, and both must reasonably/faithfully set forth the true and characteristic features of the plant for which United States Plant Patent protection is being sought.

If the bloom color designations currently set forth in the specification are determined to be correct, it would be necessary for applicant also to amend the generic bloom color description in the written specification and abstract as such would not reasonably be characterized as orange-red, but rather as pink. If such is the case, it

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would also be necessary for applicant to clarify on the record characteristic bloom color change with increasing maturity of the bloom.

Applicant should carefully review and address each of the above, and should review the instant disclosure and import into same any additional or corrected information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is being sought.

2. The claim is rejected under 35 U.S.C. 112, first and second paragraphs, as not being supported by a clear and complete botanical description of the plant, for the reasons advanced in paragraph 1 above.

3. Applicant is advised of the new mandatory procedures for amending the specification and claim under 37 CFR 1.121. Applicant may review same on the Internet at the following site:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

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4. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patents must now be addressed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

For further information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

5. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 571-272-0980, and whose normal work hours are Monday through Thursday, from 6:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Andrew Wang, can be reached at 571-272-0811.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 1600 receptionist whose telephone number is 571-272-1600.

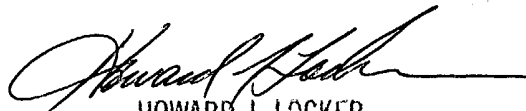
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TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to TC 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The official fax number for TC 1600 is: 703-872-9306.

Howard J. Locker/hjl

August 05, 2004


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT *1661*